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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,772	10/17/2001	Gustav Levander	P02232US0-(1	1118

7590

03/31/2003

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EXAMINER

NOLAN, SANDRA M

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 03/31/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-10

Office Action Summary

Application N .

09/889,772

Applicant(s)

LEVANDER ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-12 and 14-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

1. Claims 1-8, 10-12 and 14-24 are pending.

Amendment Entered

2. The amendment of 19 December 2002 (Paper No. 8), submitted in response to the 24 September 2002 office action (Paper No. 7), has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 19 December 2002 (Paper No. 9) was considered by the examiner.

Objections Withdrawn

4. The new abstract included in Paper No. 8 overcomes the objection set out in section 2 of Paper No. 7.
5. The spelling corrections made in Paper No. 8 overcomes the objection recited in section 3 of Paper No. 7.

Rejections Withdrawn

6. The 35 USC 112 rejection for indefiniteness set out in section 5 of Paper No. 7, is withdrawn in view of applicants' arguments on page 6 of Paper No. 8.
7. The 35 USC 103 rejection over Cubbage et al (US 5,804,215) in view of Hunter (US 6,037,033) and JP 04239607A (abstract), as set forth in section 7 of Paper No. 7, is withdrawn in order to apply the new prior art rejection set out hereinbelow.

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8. The 35 USC 103 rejection over Derr (US 6,162,516) in view of Hunter and JP-04239607A, as expressed in section 8 of Paper No. 7, is withdrawn in view of applicants' arguments on page 9 of Paper No. 8.

New Rejections

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-8, 10-12 and 14-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "wherein said polymer comprises a nicotine and oxygen barrier" is indefinite. It is unclear whether applicants intend to cover (a) an added nicotine barrier and an added oxygen barrier; or (b) an added barrier to both nicotine and oxygen.

Note, too, that the specification states, at page 6, lines 12+, that applicants employ a laminate that includes an added barrier material, not that the naphthalenate-based polymer itself "comprises" such a barrier. [Emphasis added.]

Lastly, the phrase "polymer comprises a nicotine and oxygen barrier" is not grammatically correct. A polymer molecule cannot "comprise" a barrier ingredient and still remain a distinct chemical entity.

Please clarify the claims.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-3, 5-8, 10-12 and 14-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cubbage in view of Kashimara et al (US 5,326,848).

Cubbage is discussed in section 7 of Paper No. 7. It teaches a terephthalate-based polyester, but fails to teach the use of naphthalate-based polyesters in packages for used transdermal nicotine patches.

Kashimara teaches the use of terephthalate- and naphthalate-based polyesters (col. 5, line 7) in containers (col. 1, line 22) having good barrier properties (col. 3, lines 36-40). The polyesters have glycol-derived units from ethylene glycol (col. 5, lines 27 and 29-30) and minor amounts of 1,3-propanediol.

The examiner takes official notice that a container is a package.

The patents are analogous because they deal with the use of polyesters for packaging.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the polyesters of Kashimara in the packages of Cubbage in order to improve their barrier properties.

The motivation to employ the polyesters of Kashimara in the packaging of Cubbage is found at col. 3, lines 36-40 of Kashimara, where the barrier properties of Kashimara's polyesters are discussed.

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It is deemed desirable to make packaging for used nicotine patches out of materials that have good barrier properties in order to help insure that no unspent nicotine therein can harm persons handling it.

Response to Arguments

13. Applicant's arguments with respect to claims 1-3, 5-8, 10-12 and 14-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The receptionist answers 703/308-0661.



S. M. Nolan
Patent Examiner
Technology Center 1700

SMN/smn
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26 March 2003